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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,705	04/13/2006	Yuichi Futa	2006_0545A	2366
52349	7590	11/26/2007	EXAMINER	
WENDEROTH, LIND & PONACK L.L.P.			LIM, SENG HENG	
2033 K. STREET, NW			ART UNIT	PAPER NUMBER
SUITE 800			3714	
WASHINGTON, DC 20006				

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11/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/575,705	FUTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Seng H. Lim	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 28 October 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-14 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 4/13/06, 5/24/06.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).

Miyamoto discloses a game system comprising a first game execution apparatus and a second game execution apparatus that have different internal structure from each other (Fig. 4), wherein the first game execution apparatus [0038] includes: a first program reading unit operable to read, from a first game recording medium, a first game program that indicates a procedure of a game [0020]; a first character reading unit operable to read, from a portable recording medium, character data that indicates a characteristic of a character that appears in the game [0029]; a first input unit operable to receive an inputting operation from a user; and a first game execution unit operable to proceed with the game according to the inputting operation received at the first input unit and the procedure indicated by the first game program, and make the character appear in the game in accordance with the character data read by the first character reading unit [0042], and the second game execution apparatus [0044] includes: a second program reading unit operable to read, from a second game recording medium, a second game program that indicates the procedure of the game [0021]; a second character reading unit operable to read the character data from the portable recording medium [0029]; a second input unit operable to receive an inputting operation from the user; and a second game execution unit operable to proceed with the game according to the inputting operation received at the second input unit and the procedure indicated

by the second game program, and make the character appear in the game in accordance with the character data read by the second character reading unit [0048].

**Claims 2, 4-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).

**Regarding claim 2:** Miyamoto discloses a game execution apparatus comprising program reading unit operable to read, from a game recording medium, a game program that indicates a procedure of a game [0020]; a character reading unit operable to read, from a portable recording medium, character data that indicates a characteristic of a character that appears in the game [0029]; an input unit operable to receive an inputting operation from a user [0064]; and a game execution unit operable to proceed with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048].

**Regarding claim 4:** The apparatus further includes a determining means for determining based on the data memory means if it is usable or not (i.e. authenticity). An inapplicable notifying means notifies inapplicability when not usable is determined by the use determining means [0022]. The character reading unit would inherently read the character data when the authenticity has been ensured.

**Regarding claim 5-8:** The apparatus includes a game recording medium wherein it permits change to the character's characteristics and prohibits the change of the character's characteristics according to permissible information based on a player-by-player basis in a manner discriminating one's data from others'. Each new captured character is stored or written into the portable recording medium or overwrites the pre-existing character data with the new one when the character changes [0054-0055].

**Claim 9** is rejected under 35 U.S.C. 102(b) as being anticipated by Takeda et al (US 6,190,257 B1).

Takeda et al discloses an external storage unit comprising a storage unit (Fig. 16A: 76); the external storage unit authenticate the main unit peripheral interface (i.e. game apparatus) (31:29-31); and inherently an output unit operable to, when the authenticity as been ensured, read the data from the storage unit and output the data to the game apparatus.

**Claim 10** is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).

Miyamoto discloses a game execution method comprising program reading step of reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; a character reading step of reading, from a portable recording medium, character data that indicates a characteristic of a character that appears in the game [0029]; an input step of receiving an inputting operation from a user [0064]; and a game execution step of proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048].

**Claim 11** is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).

Miyamoto discloses a game execution program comprising program reading step of reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; a character reading step of reading, from a portable recording medium, character data that indicates a characteristic of a character that appears in the game [0029]; an input step of receiving an inputting operation from a user [0064]; and a game execution step of proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048].

**Claim 14** is rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto (EP0991007A1).

Miyamoto discloses a computer-readable recording medium that stores a game execution program wherein the program has a game execution apparatus to execute a program reading step of reading, from a game recording medium, a game program that indicates a procedure of a game [0020]; a character reading step of reading, from a portable recording medium, character data that indicates a characteristic of a character that appears in the game [0029]; an input step of receiving an inputting operation from a user [0064]; and a game execution step of proceeding with the game according to the inputting operation received at the input unit and the procedure indicated by the game program, and make the character appear in the game in accordance with the character data read by the character reading unit [0048].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (EP0991007A1).

Miyamoto teaches the basic claimed apparatus as set forth above in claim 2.

Miyamoto does not disclose a request of character data from a server via a network and writing the obtained character data to portable recording medium, however, the Office takes Official Notice that connecting a game apparatus to a network server to download the character data and writing to the portable recording medium is well known in the art. At the time of invention a person of ordinary skill in the art would have found it obvious to connect the gaming apparatus to a network server and would have been motivated to do so to increase game interactions with other players in different location.

**Claims 12-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto (EP0991007A1).

Miyamoto teaches the basic claimed program as set forth above in claim 11.

Miyamoto does not disclose a request of character data from a server via a network and writing the obtained character data to portable recording medium, however, the Office takes Official Notice that connecting a game apparatus to a network server to download the character data and writing to the portable recording medium is well known in the art. At the time of invention a person of ordinary skill in the art would have found it obvious to connect the gaming apparatus to a network server and would have been motivated to do so to increase game interactions with other players in different location.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent

and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 & 2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim1 of copending Application No. 10/574078. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both are claiming a game system comprising of two game execution apparatus that obtains or reads game program; inputs operation from user; and has an execution unit operable to proceed with the game.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached USPTO form PTO-892.

***Correspondence***

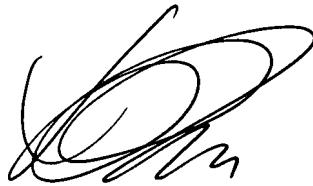
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seng H. Lim whose telephone number is 571-270-3301. The examiner can normally be reached on 8:30-6:00, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SHL

November 14, 2007



XUAN M. THAI  
SUPERVISORY PATENT EXAMINER